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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/082,254	02/25/2002	David Brown	AMBI:035USC1	3495

7590 11/18/2003

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EXAMINER

KHARE, DEVESH

ART UNIT	PAPER NUMBER
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1623

DATE MAILED: 11/18/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/082,254

Applicant(s)

BROWN ET AL.

Examiner

Devesh Khare

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-47 is/are pending in the application.
- 4a) Of the above claim(s) 34,35,37-39,41-43,45 and 47 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☒ Interview Summary (PTO-413) Paper No(s). 4.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3. 6) ☐ Other:

DETAILED ACTION

Election/Restrictions

Restriction is required under 35 U.S.C. 121 and 372.

- I. Claims 34,35,37-39,41-43,45 and 47 drawn to a kit for removing a nucleic acid probe from a sample nucleic acid, classified in class 536 and 435, subclass various.
- II. Claims 1-33, drawn to a process of removing a nucleic acid probe from a sample nucleic acid using the kit of Group I, classified in classes 536 and 435, subclass various.

The inventions are distinct, each from the other because of the following reasons:

Groups **I to II** are related as product and process of making. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for making the product as claimed can be practiced with another materially different process or (2) the product as claimed can be made in a materially different process of making that product (MPEP § 806.05(h)). In the instant case the claims are drawn to a process of removing a nucleic acid probe from a sample nucleic acid using the kit of Group I, indicating that the product can be prepared by a materially different method, Kuroita et al. disclose a method for isolating ribonucleic acid comprising three steps (see U.S. Patent 5,990,302, col. 2, Summary of the invention).

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Although the inventions are classified in the same class and sub-class, searching the two groups of inventions constitutes a burdensome search, as a thorough search comprises a search of foreign patents and non-patent literature as well as the appropriate U.S. patent classifications. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their divergent subject matter, restriction for examination purposes as indicated is proper. It is noted that examination of the two independent and distinct inventions would indeed impose an undue burden upon the examiner in charge of this application.

Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement is traversed (37 CFR 1.143). If applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims, which depend from or otherwise include all the limitations of the allowable product claim will be rejoined. (MPEP § 821.04)

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(h).

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A telephone call was made to Mark Wilson on 11/04/03 to request an oral election to the above restriction requirement. During telephone conversation with Mark Wilson, a provisional election was made with traverse to prosecute the invention of Group II, claims 1-33. Affirmation of this election must be made by applicant in replying to this Office action. Claims 34,35,37-39,41-43,45 and 47 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention. It is noted that the applicant in "Preliminary amendment and species requirement" has elected the species "methods for stripping nucleic acid using enzymes and kit for same". Therefore, claims 9, 10, 16 and 17 are also withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claims 1-8, 11-15, and 18-33 are currently pending in this application.

35 U.S.C. 112, second paragraph rejection

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-8, 11-15, and 18-33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(1) The term "nucleic acid probe" in claim 1 is relative, and the recitation of same renders the claim indefinite. The terms "nucleic acid probe" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and

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one of ordinary skill in the art would not be reasonably apprised of the scope of the invention with regard to the releasing agent.

(2) Claims 1 and 31 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: use of an enzyme in breaking at least a first bond of the nucleic acid probe.

(3) Claims 20-30 are vague and indefinite as it is unclear whether the term "attaching" is intended to be included in the steps between a) and b), b) and c) or after c).

Claims which depend from an indefinite claim which fail to obviate the indefiniteness of the claim from which they depend are also seen to be indefinite and are also rejected for the reasons set forth supra.

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims **1-8, 11-15, and 18-33** are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-18 of Brown et al. (U.S. Patent No. 6,365,731)('731).

The '731 patent discloses in claims 1 and 17 a method of stripping a nucleic acid probe from a sample nucleic acid by cleaving said sample nucleic acid by an enzyme. The '731 patent discloses a kit for removing a nucleic acid probe from a sample nucleic acid comprising a nucleic acid polymerase (see claim 18). The '731 patent also discloses in a method of stripping a nucleic acid probe the components involved such as phosphodiester or phosphorothioate bond, DNA polymerase, sample nucleic acid comprising DNA or RNA, a solid support is a membrane, bead, glass or resin, an ion-exchange chromatography, and electrophoresis (see claims 1-17). The '731 patent differ from the applicant's invention that the claims of the '731 patent are directed to a method for stripping nucleic acids using iodine and kit to same.

The examiner notes the instant claims and the '731 claims do indeed substantially overlap and this obviousness-type double patenting rejection is necessary to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Devesh Khare whose telephone number is (703)605-


1199. The examiner can normally be reached on Monday to Friday from 8:00 to 4:30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James O. Wilson, Supervisory Patent Examiner, Art Unit 1623 can be reached at 703-308-4624. The official fax phone numbers for the organization where this application or proceeding is assigned is (703) 308-4556 or 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

Devesh Khare, Ph.D.,JD(3Y).
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October 14,2003



JAMES O. WILSON
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600